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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,597	06/15/2001	Edward Michael Silver	36968.203978 (BS00148)	8298

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EXAMINER

SALL, EL HADJI MALICK

ART UNIT

PAPER NUMBER

2157

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/882,597

**Applicant(s)**

SILVER ET AL.

**Examiner**

El Hadji M. Sall

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 20-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This action is responsive to the amendment filed on January 31, 2007. Claims 1-9 and 20-30 are pending. Claims 1-9 and 20-30 represent electronic mail (email) Internet application methods and systems.

2. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "all non-text attachments **automatically deleted**" is not found in the specification, and is a negative limitation.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

For purpose of prior art rejection, examiner will construe it as “all non-text attachment deleted”.

**3. *Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements

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of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4-9 and 20-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsai U.S. 6,839,741.

Tsai teaches the invention as claimed including facility for distributing and providing access to electronic mail message attachments (see abstract).

As to claims 1 and 21, Tsai teaches a method and a system of manipulating email messages with an email network appliance comprising:

receiving an email message with an email network appliance that can only provide the text of a message, the email message having had all non-text attachments deleted such that the email message is text only (column 1, line 66 to column 2, line 6);

Classifying the text only email message (column 2, line 4-6);

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Inserting the text only email message into a classification container (column 2, lines 9-11; figure 4, item 86); and

Presenting the classification container in a classification display section (column 5, lines 62-64)

As to claim 2, Tsai teaches the method of claim 1, further comprising prompting a user to save a sent email message (figure 4, item 86).

As to claims 4 and 24, Horvitz teaches the method and system of claims 1 and 23, wherein the email network appliance comprises an apparatus connected to a public switch network via an RJ-11 interface (column 5, lines 65-67).

As to claim 5, Tsai teaches the method of claim 1, wherein the email network appliance comprises an apparatus comprising a keyboard (column 5, line 65).

As to claims 6 and 16, Tsai teaches the method of claims 1 and 8 respectively, wherein the email network appliance comprises an email Internet appliance (figure 1).

As to claim 7, Tsai teaches the method of claim 3, further comprising prompting a user to save a sent email message (figure 4, item 86).

As to claim 8, Tsai teaches the method of claim 6, further comprising prompting a user to save a sent email message (figure 4, item 86).

As to claim 9, Tsai teaches the method of claim 1, wherein the display classification section comprises at least two sections, each section containing one classification container (figure 4, items 84 and 86).

As to claims 20 and 29, Tsai teaches the method and system of claims 1 and 22, further comprising reading a text only email message in a classification container, wherein all reading is performed off-line (figure 4, Tsai discloses the architecture of for the computer system of the recipient 14, the text only message is stored in the container 86, and inherently will be read off-line as needed).

As to claim 22, Tsai teaches the system of claim 21, further comprising: a client configured for receiving email message from a server, for classifying each of the plurality of email messages, for inserting the email message into a classification container, and for presenting the classification container is a classification display section (column 1, line 66 to column 2, line 11; column 5, lines 62-64).

As to claim 23, Tsai teaches the system of claim 22, wherein the client is housed in an email network appliance (figure 5).

As to claim 25, Tsai teaches the system of claim 23, wherein the email network appliance comprises an apparatus comprising a keyboard (column 5, line 65).

As to claim 26, Tsai teaches the system of claim 23 respectively, wherein the email network appliance comprises an email Internet appliance (figure 1).

As to claim 27, Tsai teaches the system of claim 22, further comprising prompting a user to save a sent email message (column 3, lines 34-38; column 5, lines 45-50).

As to claim 28, Horvitz teaches the method of claim 22, wherein the display classification section comprises at least two sections, each section containing one classification container (figure 4, items 84 and 86).

**5.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the



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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai U.S. 6,839,741.

Tsai teaches the invention substantially as claimed including facility for distributing and providing access to electronic mail message attachments (abstract).

As to claim 3, Tsai teaches the method of claim 1, wherein the email network appliance comprises an apparatus comprising a scrollable line display (figure 1, item 14).

Tsai fails to teach explicitly a scrollable line display capable of presenting at least six lines but no more than fifteen lines.

However, Cooper teaches internet answering machine. Cooper teaches a scrollable line display capable of presenting at least six lines but no more than fifteen lines (column 5, lines 9-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tsai in view of Cooper to provide a scrollable line display capable

of presenting at least six lines but no more than fifteen lines. One would be motivated to do so to allow just a certain number of lines on display to avoid overloading the display.

As to claim 30, Tsai teaches a method of manipulating email messages with an email network appliance comprising:

Receiving an email message with an email network appliance that can only provide the text of a message, the email message having had all non-text attachments deleted such that the email message is text only (column 1, line 66 to column 2, line 6);

Classifying the text only email message (column 2, line 4-6);

Inserting the text only email message into a classification container (column 2, lines 9-11; figure 4, item 86);

Presenting the classification container in a classification display section comprising at least two sections, each section containing one classification container (column 5, lines 62-64; figure 4, items 82, 84 and 86);

Presenting a text only email message in a classification container, wherein all presenting of the text only email message is performed off-line and prompting a user to save a sent email message (figure 4, item 86, Tsai discloses the architecture of for the computer system of the recipient 14, the text only message is stored in the container 86, and inherently will be read off-line as needed;

Wherein the email network appliance comprises a handheld email internet appliance connected to a public switch network via an RJ-11 interface, the appliance

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further comprising a keyboard and a scrollable line display (figure 1, item 14; column 5, lines 65-67).

Tsai fails to teach explicitly a scrollable line display capable of presenting at least six lines but no more than fifteen lines.

However, Cooper teaches internet answering machine. Cooper teaches a scrollable line display capable of presenting at least six lines but no more than fifteen lines (column 5, lines 9-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tsai in view of Cooper to provide a scrollable line display capable of presenting at least six lines but no more than fifteen lines. One would be motivated to do so to allow just a certain number of lines on display to avoid overloading the display.

## **7. *Response to Arguments***

Applicant's arguments filed 01/31/07 have been fully considered but they are not persuasive.

Applicant argues that even if, arguendo, Tsai teaches the removal of attachments from the email message, it fails to teach receiving the email message with an email network appliance that can only provide the text of a message. In Tsai, the application is removed for later access by the receiving device. "[R]ecipients of emails still have the

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ability to view the attachments and can download the attachments, if desired, at their leisure.

In regards to the above point, examiner respectfully disagrees.

The Examiner kindly submits that the applicant(s) misread the applied references used in the rejection. Actually, applicants are interpreting the claims very narrow by considering the broad teaching of the references used in the rejection. The aforementioned assertion wherein Tsai "fails to teach receiving the email message with an email network appliance that can only provide the text of a message " was unsupported by objective factual evidence and was not found to be of substantial evidential value. For this assertion to have merit, it is important to applicants to provide some forms of evidence that convincingly show that Examiner's references do not meet the claims language. Furthermore, Applicants are reminded that 37 CFR 1.111(b) states, "a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirement of this section". Thus, applicants' assertions are just mere allegation with no supported fact by failing to specifically point out how the language of the claims patentably distinguished them from the cited references. Applicants are reminded that the Examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the Examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969). Hence the

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35 U.S.C 102 is hereby sustained. Furthermore, Applicant admitted that Tsai teaches the removal/deletion of attachments from the email message. In column 1, line 66 to column 2, line 6, Tsai discloses an electronic mail message for a recipient is received at a first device, such as a computer system. The electronic mail message includes both text and attachment. The attachment is removed from the electronic mail message and stored at the first device. The text of the electronic mail message is sent from the first device to the recipient at the second device.

The mere fact that "recipients of the emails still have the ability to view the attachments and can download the attachments, if desired, at their leisure" does not exclude Applicant's invention having the same functionality as Tsai's. Furthermore, Tsai's invention has extra functions that Applicant's claimed invention does not have.

**8.*****Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to El Hadji M Sall whose telephone number is 571-272-4010. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

El Hadji Sall  
Patent Examiner  
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